# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/943,892 | 08/29/2001 | Eric D. Anderson | 500247.03 | 2384 |

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| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|  | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/943,892 | ANDERSON, ERIC D. |
|  | Examiner | Art Unit |  |
|  | DAVID E. ENGLAND | 2143 |  |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *21 November 2007*.
2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *30, 32 – 36 and 45 – 50* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *30, 32 – 36 and 45 – 50* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

## DETAILED ACTION

1.      Claims 30, 32 – 36 and 45 – 50 are presented for examination.

### *Claim Rejections - 35 USC § 112*

2.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.      Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

4.      Claim 48 does not positively state that the claim limitation. The limitations states that it

the email notification **<u>can</u>** vary based on each recipient's preferences. The limitation never states

that is does perform this limitation. Applicant is asked to amend this limitation to positively state

that the method does perform this task.

### *Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains.  Patentability shall not be negatived by the
> manner in which the invention was made.

**6.      Claims 30, 33 – 35 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) and what is well known in the art.**

7.      Referencing claim 30, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email, comprising:

8.      receiving on a recipient's computer an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);

9.      requesting from the server the referenced Email communication, the request being sent to the Email communication program from the recipient's computer system, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients;

10.      receiving by the recipient's computer system from the server, the requested Email communication.

11.      tracking each recipient's delete and save instruction;

12.      saving the Email communication on the server if any one of the recipients indicate it is to be saved; and

13.     when it is determined that the Email communication has been sent and accessed by all of the recipients, deleting the stored Email communication by the Email communication program if none of the recipients indicate it is to be saved.

14.     Arnold teaches providing an Email communication program on a server that is configured with instructions to store a single copy of a section of the Email communication on the server if the Email communication is designated for the plurality of recipients, (e.g. col. 3, line 57 – col. 4, line 42);

15.     receiving by the recipient's computer system from the server, the requested section of the Email communication, (e.g. col. 3, line 57 – col. 4, line 42); and

16.     tracking each recipient's delete and save instruction, (e.g., col. 4, lines 43 – 57, *"... recipients may do is delete themselves from the list."*);

17.     saving the Email communication on the server if any one of the recipients indicate it is to be saved, (e.g., col. 3, lines 3 – 9, *"... which allows recipients of an electronic message to access, edit and save new versions of remotely located attachments..."*); and

18.     when it is determined that the Email communication has been sent and accessed by all of the recipients, deleting the stored Email communication by the Email communication program if none of the recipients indicate it is to be saved, (e.g., col. 4, lines 43 – 57, *"Such deletion from the access list may occur at the instruction of the recipient or may occur automatically after for first access... Once the access list goes to null (i.e., all the intended recipients are deleted from the access list), the attachment is deleted from the server"* & col. 5, lines 36 – 44, *"a sender of a message may define the access rights of the remotely-located attachment. For example, access may be limited to only those recipients of the e-mail message. The rights may include read only;*

*read and save only… The attachments may also be subject to access control rights designated by entities other than the sender of the message.”*).

19.     Furthermore, it can be understood by the prior art of Arnold, if a recipient wishes to be taken off the list, the recipient is indicating that they wish to be done with the attachment and therefore have no need to have it saved on a server anymore and therefore can be deleted since once all recipients have been taken off the list the attachment can be automatically deleted. It is also reminded to the Applicant that it is well known in the art that the sender of an email can CC: or BCC: themselves and therefore also become a recipient.

20.     It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an attachment taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email so incase the user is off line and wants to modify the local copy of the attachment, the user could with out modifying the original attachment that could be used as an archived document for reference if desired. Arnold does not specifically teach storing a single copy of an email message. It would have been obvious to one of ordinary skill in the art to store a single copy of an email instead of just an attachment since it is well known in the art that an email is nothing more than a message or document sent between users and it would only take one of ordinary skill in the art to, instead of storing a single copy of an attachment, which can also be considered a message, storing a single copy of an email utilizing the teachings of

Arnold's criteria for storing a single copy of a message or document. Arnold teaches adding

users to the access list, which would allow a new user rights to view the document but does not

specifically teach forwarding, (e.g. col. 5, lines 51 – 57, *"a recipient may be added if certain*

*modification rules are met."*). Forwarding electronic messages to another user in an email

system is well known in the art at the time the invention was made and would only take one of

ordinary skill in the art to forward the electronic message to a new users and add them to an

access list, which would give the user the ability to view the document saved in a storage device.


21.     As per claim 33, Dillon does not specifically teach storing the Email communication

locally by the recipient on the recipients computer system such that the local stored Email

communication is preserved even when the Email communication program deletes the single

stored copy of the Email communication from the server.

22.     Official Notice is taken that it was a common practice to store the Email communication

locally by the recipient on the recipients computer system such that the local stored Email

communication is preserved even when the Email communication program deletes the single

stored copy of the Email communication from the server at the time the instant invention was

made.

23.     It would have been obvious to one having ordinary skill in the computer art at the time of

the invention was made to modify the method disclosed by Dillon because of similar reasons

stated above. Furthermore, if the user saves the Email locally on one computer and disconnects

from the network and then logs in on a different computer and deletes the Email on the server

there is no way for the Email to be deleted on the first computer. Also if the user were to save the

Email on a floppy disk and then delete the Email form the server, the server cannot delete the

Email on the floppy disk, especially if the floppy disk is removed.

24.     Applicant has failed to seasonably challenge the Examiner's assertions of well known

subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP

§2144.03.  A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in

the next response.  Accordingly, the claim limitations the Examiner considered as "well known"

in the first Office action, i.e. "storing the Email communication locally by the recipient on the

recipients computer system such that the local stored Email communication is preserved even

when the Email communication program deletes the single stored copy of the Email

communication from the server," are now established as admitted prior art of record for the

course of the prosecution.  See In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).


25.     As per claim 34, as closely interpreted by the Examiner, Dillon teaches the Email

communication received from the server is encrypted using a public encryption key for the one

of the plurality of designated recipients, and including retrieving a private encryption key for the

one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line

60 – col. 10, line 15).


26.     As per claim 35, as closely interpreted by the Examiner, Dillon and Arnold teach all that

is similar in nature to claims 30 and 34, more specifically, Dillon teaches the acts of receiving

the notification, requesting the Email communication and receiving the Email communication

are performed by a receiving computer lacking sufficient permanent storage to store the Email

communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).

27.    As per claim 46, as closely interpreted by the Examiner, Dillon teaches the Email

communication notification received from the server is encrypted, (e.g. col. 9, line 60 – col. 10,

line 15).

28.    As per claim 47, as closely interpreted by the Examiner, Dillon does not specifically

teach the Email communication notification is a link to the Email communication. Arnold

teaches the Email communication notification is a link to the Email communication, (e.g., col. 2,

lines 27 - 37). It would be obvious to one of ordinary skill in the art at the time the invention was

made to combine Arnold with Dillon since it is widely known in the art that utilizing a data link

in a document or any type of message can route someone to a web page that they desire to view

when it is selected.

29.    As per claim 49, as closely interpreted by the Examiner, Dillon does not specifically

teach act of requesting from the server the referenced Email communication further comprises

determining whether a requester has access to view the message. Arnold more specifically

teaches act of requesting from the server the referenced Email communication further comprises

determining whether a requester has access to view the message, (e.g., col. 4, lines 43 – 57). It

would be obvious to one of ordinary skill in the art at the time the invention was made to

combine Arnold with Dillon because allowing the use of an access list allows the system to keep

the access to the email exclusive to only those that originally received the notification that there

is a document waiting for them.


30.     As per claim 50, as closely interpreted by the Examiner, Dillon teaches storing the email

communication to a recipient computer system, (e.g., col. 6, lines 1 – 16).


31.     Claim 45 is rejected for similar reasons as stated above.


**32.     Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon and**

**Arnold in further view of Devine et al. (6385644) (hereinafter Devine).**


33.     As per claim 32, as closely interpreted by the Examiner, Dillon and Arnold do not

specifically teach receiving the Email communication notification, storing the Email

communication notification locally on the recipient's computer system.

34.     Devine teaches receiving the Email communication notification, storing the Email

communication notification locally on the recipients computer system, (e.g. col. 12, lines 40 –

55). It would have been obvious to one skilled in the art at the time the invention was made to

combine Devine with the combine system of Dillon and Arnold because of similar reasons stated

above and further, if a user has a personal records of Email communication notifications it could

prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).

**35.     Claims 36 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Dillon and Arnold and in further view of Homan et al. (6317485).**

36.     Referencing claim 36, as closely interpreted by the Examiner, Dillon and Arnold do not

specifically teach wherein contents of the received Email communication notification are based

on preferences for the one of the plurality of designated recipients, the preferences previously

supplied to the server configured with the Email communication program. Homan teaches

wherein contents of the received Email communication notification are based on preferences for

the one of the plurality of designated recipients, the preferences previously supplied to the server

configured with the Email communication program, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 –

44). It would have been obvious to one skilled in the art at the time the invention was made to

combine Homan with the combine system of Dillon and Arnold because of similar reasons stated

above and further it would be more efficient for a system to utilize a type of preference setting to

classify or possibly utilize different types of Email communication notifications. This will

diversify the way a user may receive notifications about incoming Email.

37.     Claim 48 is rejected for similar reasons as claim 36, with the cited area of Homan

teaching the claim language.

***Response to Arguments***

38.    Applicant's arguments filed 11/21/2008 have been fully considered but they are not

persuasive.


39.    **In the Remarks**, Applicant argues in substance that the prior art of Dillon and Arnold

teach away from storing a single copy of the email itself because the email is already in ASCII

format and thus there is no reason to store the email itself to the server.


40.    As to the first remark, as previously argued, it can be interpreted that an email that is sent

could be only an attachment with the information needed to be seen. Arnold sees this and

supplies a link as to where the attachment will be stored. The email that was sent is now without

an attachment and now has a link and can now be interpreted as a notification to a recipient that

there is an email message waiting to be viewed, since it can be interpreted that the email message

is in the attachment. Furthermore, the section of Arnold that stated the pointer to the attachment

is in the "test of the email message" can be understood to anyone of ordinary skill in the art to

mean it is in the body of the email where text can be typed and links selected.

41.    In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., Applicant's

arguments regarding the logic of ASCII format) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims.  See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993).

42.    Applicant is also asked to view the prior art of Birrell et al. U.S. Pat. No. 6009462 which could also be utilized to reject this application in a possible 103 type rejection, i.e., Fig. 10 and supporting specification areas.

43.    **In the Remarks**, Applicant argues in substance that the prior art of Dillon and Arnold tracking each recipient's instructions and more specifically their save and delete instructions.

44.    As to the second remark, Examiner would like to point out to the Applicant that the claim language is broad and does not specifically state What the system's save and delete actions pertain to, i.e., are we saving and deleting users from seeing the email, are we saving and deleting the email itself in this step, etc. Since this is still a broad limitation Arnold's list of adding and saving more recipients on the access list and removing people from the access list can be interpreted in this limitation. Arguendo, if the Applicant means for this limitation to be the saving and deleting of the email itself, it can be considered that the recipients ability to have the have the access list marked as not read is the same act and/or has the same outcome as saving the attachment on the server since the list has to go to null in order to delete the message on the server. The same logic is applied to deleting. If a user view the list and marks the list to designate they have seen the email, then the system treats this as the one recipient does not wish to save or does not care what happens to the attachment after their viewing and therefore acts as the user deleting it. All of this is tracked by the list and can be interpreted as tracking whether the recipient's wish to save or delete the attachment message.

45.    All other arguments fall under these two remarks and have therefore been responded to.

46.     If Applicant wishes to contact the Examiner to further discuss the claim language and

interpretations, it would be advised to do such.


### *Conclusion*

47.     Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DAVID E. ENGLAND whose telephone number is (571)272-

3912.  The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan J. Flynn can be reached on 571-272-1915.  The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

<div style="text-align:right">

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